

Remarks

Applicants request favorable reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1, 3, 4, 7, 9-12, 27-29, 31-33, 38, and 42-57 are pending in this application, with Claims 1, 27-29, 31, 38, 42, 46, 48, 51, and 54-57 being independent.

Claims 1, 31, 38, 48 and 51 have been amended. Claim 57 is newly presented. Applicants submit that no new matter has been added.

The Office Action indicates that since the application was filed with informal drawings, formal drawings will be required when the application is allowed. However, formal drawings were submitted along with the May 11, 2004 Amendment in the subject application. Applicants request acknowledgment of the formal drawings in the next official communication.

Claims 1, 3, 4, 7, 9-12, 22, 27-29, 31, 38 and 42-56 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,029,182 (Nehab et al.) in view of U.S. Patent No. 6,012,083 (Savitzky et al.). Claims 32-33 have been rejected under 35 U.S.C. § 103(a) as being obvious over Nehab et al. in view of Savitzky et al., and further in view of U. S. Patent No. 5,633,996 (Hayashi et al.). These rejections are respectfully traversed.

Applicants submit that the cited documents, whether taken alone or in combination (assuming *arguendo* that they can be combined), fail to disclose or suggest salient features of Applicants' invention, as presently recited in the independent claims. In particular, Applicants submit that there is no disclosure or suggestion in either Nehab et al.

or Savitzky et al. of a method, operable in a first application upon a local machine, of forming a single continuous printable document by collating a plurality of hyper-text documents, said method comprising, *inter alia*, the step of monitoring access patterns of a second application operating independently of said first application on said local machine, to identify the plurality of hyper-text documents accessed independently by the second application, as presently recited in independent claim 1.

The Office Action acknowledges, at the bottom of page 3, that the Nehab et al. patent fails to disclose monitoring access patterns of a second application operating independently of said first application on said local machine, to identify the plurality of hyper-text documents accessed independently by the second application. The Office Action asserts that these features are met by the teaching of Savitzky et al. of an independent agent for providing a history of all the documents accessed by a client.

Applicants respectfully disagree. Applicants assert that the Savitzky et al. patent discloses a web agency application that is interposed between a web client application and a web server application, so as to intercept information which passes between the client and the server. The web agency application obtains a historical log of the intercepted information, which may be used by further applications. The Office Action asserts that this log record made by Savitzky et al. may be used to provide a personal profile input equivalent to that required by Nehab et al. so that web documents can be subsequently retrieved and formatted into a printable document. Applicants submit that even if, for the sake of argument, such a combination is permissible, the combination would not result in Applicants' invention as defined by independent claim 1.

Along with the May 11, 2004 Amendment in the subject application, Applicants provided illustrations intended to generally represent the present invention, the prior art citations, and any reasonable combinations thereof. Applicants continue this by offering previously filed Figs. A and B (Fig. A representing Applicants' present invention and Fig. B representing the prior art Nehab et al. patent), and new Figs. E and F (Fig. E representing the Savitzky et al. patent and Fig. F representing what Applicants believe would be the resulting combination of the teachings of the Savitzky et al. and Nehab et al. patents ("the combination of Nehab et al. and Savitzky et al.")). Figs. A, B, E, and F are attached as Exhibit A.

Referring to Fig. E, the Savitzky et al. patent discloses a client browser application (second application) which communicates via a transparent agency application (first application) with a server forming access to the world wide web (www). In this fashion, the browser application can deliver URLs to the www and receive documents in return. The interposed transparent agency application, according to the Savitzky et al. patent, is able to monitor those URLs that are forwarded to the web and documents that are returned, to form a log file which represents a historical record of access to the web, and perhaps may include document information as well. That log file may can be used by a further client application.

Importantly, as stated in column 3, line 45 of the Savitzky et al. patent, the agency application is "interposed between the various clients used by a user and the various servers accessed by those clients." Also, the Savitzky et al. patent, at col. 4, lines 17-19, states that one advantage of the "Web agency is that it decouples information management

from information display, thereby making these tasks independent.” In this regard, the “information management” being referred to in the Savitzky et al. patent is that arguably performed by the client application that operates using the log file, and the “information display” is the return of information directly to the client browser for consumption by the user. While the arrangement of the Savitzky et al. patent may appropriately decouple those two tasks, it is apparent from Fig. E and from Fig. 1 of the Savitzky et al. patent that the client browser in operation is dependent upon appropriate handling of requests and deliveries via the agency application.

The method of Applicants’ claim 1 is one that is operable in a “first application” on a local machine. Importantly, the first step of claim 1 is “monitoring access patterns of a second application operating independently of said first application on said local machine”. In the subject application, the “second application” is preferably a browser application, as illustrated in Fig. A. By corollary, the “second application” in the Savitzky et al. patent must also be construed to be the client browser. In the present invention, the “first application” operating on the local machine is that which performs the monitoring and the subsequent retrieval and formatting for display operations. In the Savitzky et al. patent, the “agency” is the “first application” which operates to create the log. However, as is seen from Fig. E, while the Savitzky et al. patent may teach a “first application”, the second application (the client browser) does not operate independently of the first application (the agency).

Moreover, in the present invention recited in claim 1, the hypertext documents are accessed independently by the second application. Applicants submit that

in the Savitzky et al. patent, any access to hypertext documents is not independent of operation of the agency. Rather, all access occurs through the agency. This is completely at odds with the foregoing feature of the present invention, as recited in independent claim 1.

Referring now to Fig. F, Applicants submit that Fig. F, corresponds to the combination of the teachings of the Savitzky et al. and Nehab et al. patents (attached Figs. B and E), assuming that such combination is even permissible. As seen from Fig. F, the browser and agency arrangement of the Savitzky et al. patent is retained, as is the log file. However, when combining this teaching with the features of the Nehab et al. patent, the log file is interpreted as being, at best, an input to the personal profile of the Nehab et al. patent, which then couples with the retrieval and formatter which, in turn, couples with the web reader to obtain documents from the web server for producing the printable document.

In this regard, Applicants submit that it is inherent that the retrieval and formatter of the Nehab et al. patent couples with a web reader which is a separate application from the personal profile arrangement of Nehab et al. In this respect, the use of the web reader of the Nehab et al. patent in Fig. F, is essential so that documents may be subsequently retrieved from the web for “off-line” document formatting and printing. The net result of the combination is that there are at least four separate applications operating in the combination of the Savitzky et al. and Nehab et al. patents, all of which require operation of the browser dependent upon the operation of the agency.

Applicants further note that the web reader of the Nehab et al. patent cannot be combined with or utilize the functionality of the client browser of the Savitzky et al.

patent, as a single “second application”, because when a “retrieval” operation according to the Nehab et al. patent were to be performed, the client browser of the combined arrangement would again have to request the document, transmitting such a request through the agency. The agency would, therefore, duplicate a log file record which would then be provided to the personal profile again for subsequent retrieval. This would result in the creation of a nonsensical record and could result in the continuous creation of the same document by the third application of the combined Savitzky et al. and Nehab et al. arrangement.

As is seen from a comparison of attached Figs. A, E, and F, the disclosure of the Savitzky et al. patent does not correspond to Applicants’ claimed invention, as shown in Fig. A, because it does not decouple the monitoring from the operation of the browser. As clearly seen from Fig. A, the operation of the browser is entirely independent of the operation of the monitoring and retrieval arrangements. The independence of these two applications provides a significant advantage in terms of user control and the ability to subsequently edit the display list to ensure that any document that is printed meets with a user’s desires. In the combination of Nehab et al. and Savitzky et al., since all required browser requests are transmitted through the agency, there is a dependence of operation.

The lack of independence between the browser and the agency is highlighted by the disclosure at column 3, line 65 to column 4, line 6 of the Savitzky et al. patent, that the arrangement may be implemented in a computer distinct from the web client. This is contrary to the present invention recited in claim 1, which recites the specific limitation of the two applications being operable on the same local machine. It is

this express limitation of the two applications being operable on the local machine that provides for the first application performing the claimed method, to operate independently of the second application (the browser). Because Savitzky et al. permits this arrangement involving the decoupling of the client browser from the agency, it is therefore essential to the arrangement disclosed in the Savitzky et al. patent that the browser operate dependently on the agency. Applicants have been unable to find any teaching in Savitzky et al. that operation of the browser can be performed independent of operation of the agency.

The Hayashi et al. patent was cited for its teaching of “maximizing the number of hyper-text documents on each page” However, the Hayashi et al. patent fails to remedy the foregoing deficiencies noted with respect to the Nehab et al. and Savitzky et al. patents.

Therefore, Applicants submit that none of the cited patents, whether taken singly or in the combinations suggested by the Examiner, disclose or suggest the features of independent claim 1. Accordingly, Applicants submit that claim 1 is allowable over the cited art. Reconsideration and withdrawal of the § 103 rejections are respectfully requested.

Independent claims 27-29, 31, 38, 42, 46, 48, 51, and 54-57 are variously directed to methods, computer implemented methods, computer systems, computer readable media, computer program products, and computer apparatus. Each of the independent claims recites patentable features along the lines of those discussed above with respect to independent claim 1.

For the foregoing reasons, Applicants respectfully submit that the present invention is patentably defined by the independent claims. The dependent claims are also allowable, in their own right, for defining features of the present invention in addition to those recited in their respective independent claims. Individual consideration of the dependent claims is requested.

Applicants submit that the present application is in allowable form. Favorable consideration and passage to issue of the present application at the Examiner's earliest convenience are requested.

Request for Telephone Interview

In the event that outstanding issues remain after entry of this Amendment, Applicants request that the Examiner contact Applicants' undersigned representative to schedule a telephone interview.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to the below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David A. Divine". The signature is fluid and cursive, with a large initial "D" and "A".

Attorney for Applicants
David A. Divine
Registration No. 51,275

Attachments: Figs. A, B, E, and F (two sheets)

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200
DAD:ayr

DC_MAIN 188647v1